

**Certificate of Transmission by Mailing, Facsimile, or Electronic Transmission (37 C.F.R. §1.8)**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is:

☐ being deposited with the U.S. Postal Service on the date indicated below and with sufficient postage addressed to Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.☐ being facsimile transmitted to the Commissioner for Patents, U.S.P.T.O. (Fax No. 571-273-8300) on the date indicated below.☒ being transmitted to the Commissioner for Patents via the U.S.P.T.O. Electronic Filing System on the date indicated below.

Signature: /Gary R. Fabian/ Reg. No. 33,875

Date: 15 January 2010

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of: FEREIRA, Pamela, et al.

Confirmation No.: 7505

Serial No.: 10/815,169

Art Unit: 1615

Filing Date: 31 March 2004

Examiner: Al-Awadi, D.J.

Title: OSMOTIC DELIVERY SYSTEM AND METHOD FOR DECREASING START-UP TIMES FOR OSMOTIC DELIVERY SYSTEMS

**RESPONSE TO RESTRICTION REQUIREMENT AND AMENDMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in response to the Restriction Requirement in the above-referenced application, mailed 23 December 2009. No fees are believed to be due. However, the Commissioner is hereby authorized to charge to Deposit Account No. **504212** any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, with the exception of the payment of the Issue Fee. Consideration of the application in view of the following election and remarks is respectfully requested.

## **I. Overview of the Amendments**

### **1. To the Specification**

Paragraph 0039 of the specification is amended to correlate the numbering of the chambers (i.e., first and second chambers) to the numbering of the ends of the reservoir (i.e., first and second ends). Basis for the amendment to the specification can be found, for example, in Figure 1 and in ¶0031 and ¶0038.

Accordingly, no new matter has been added by way of this amendment and the entry thereof is respectfully requested.

### **2. To the Claims**

Claims 1-31 are pending in the application. Claims 1, 4-13, 15, 16, and 19-31 are amended without prejudice or disclaimer. Claims 2 and 17 are canceled by this amendment without prejudice or disclaimer. Applicants expressly reserve the right to bring the subject matter of the previously presented claims again in a subsequent, related application. After entry of this amendment claims 1, 3-16, and 18-31 are pending.

The amendments to the claims are presented herein below (after the signature page) in the section titled “Amendments to the Claims.”

Basis for the amendments to claim 1 can be found throughout the specification, for example, at the following locations: ¶0023; ¶0039; and original claims 2 and 12.

Basis for the amendments to claim 12 can be found throughout the specification, for example, at the following location: ¶0023.

Basis for the amendments to claim 15 can be found throughout the specification, for example, at the following locations: Figure 1; ¶0013; ¶0022; and ¶0039.

Basis for the amendments to claim 16 can be found throughout the specification, for example, at the following locations: Figure 1; ¶0023; ¶0031; ¶0035; ¶0038-0039; and originally presented claims 17 and 27.

Basis for the amendments to claim 27 can be found throughout the specification, for example, at the following location: ¶0023.

Basis for the amendments to claim 29 can be found throughout the specification, for example, at the following location: ¶0031.

Claims 4-11, 13, 19-26, 28, and 30-31 are amended to recited an organic liquid filler.

Basis for this amendment can be found throughout the specification, for example, at the following locations: originally presented claims 12 and 17; and ¶0023.

Accordingly, no new matter has been added by way of this amendment and the entry thereof is respectfully requested.

## **II. Response to Restriction Requirement**

This election is in response to the Restriction Requirement, mailed 23 December 2009. The Examiner therein required election of one of the following groups of claims:

- I. Claims 1-15, drawn to an osmotic drug delivery device, classified in class 424, subclass 468.
- II. Claims 16-31, drawn to a method of reducing the delivery start-up time of an osmotic delivery device, classified in class 424, subclass 468.

Applicants hereby elect to prosecute the claims of Group I, claims 1-15, without traverse. Applicants expressly reserve their right under 35 U.S.C. §121 to file one or more divisional applications directed to the non-elected subject matter during the pendency of this application.

## **III. Rejoinder of the Claims**

In the Office action, mailed 23 December 2009, the Examiner noted the following:

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined. (Office action, mailed 23 December 2009, page 4.)

Method claims 16-31 are withdrawn by this amendment. However, these claims recite essentially the same components of the osmotic delivery device that are recited in claims 1-15, those components being (i) a reservoir, (ii) an osmotic composition contained within the reservoir, (iii) a drug formulation contained within the reservoir, (iv) a piston, and (v) a preloaded membrane. The withdrawn method claims will be amended to reflect any amendments made to the pending claims of Group I and thus will contain any required limitations of allowable product claims. Accordingly, rejoinder of the method claims upon indication of allowable product claims will be requested by Applicants and is appropriate because the process claims will be commensurate in scope with any allowed product claims.

**IV. Conclusion.**

Applicants respectfully submit that the claims comply with the requirements of 35 U.S.C. §112 and define an invention that is patentable over the art. Accordingly, a Notice of Allowance is believed in order and is respectfully requested.

Please direct all further communications in this application to:

**Customer Number: 000074866**

Barbara G. McClung, Esq.  
Registration No. 33,113  
Vice President, General Counsel and Corporate Secretary  
Intarcia Therapeutics, Inc.  
24650 Industrial Blvd.  
Hayward, CA 94545  
Phone: 510-782-7800, ext. 122  
Facsimile: 510-782-7801.

If the Examiner notes any further matters that the Examiner believes may be expedited by a telephone interview, the Examiner is requested to contact the undersigned at (650) 780-9030.

Respectfully submitted,

Date: 15 January 2010

By: /Gary R. Fabian/

Gary R. Fabian, Ph.D.  
Registration No. 33,875  
Agent for Applicants